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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,566	03/30/2001	Jay H. Connelly	42390P10859	6351

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/823,566	CONNELLY, JAY H	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-11 and 13-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-11 and 13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *31 July 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5, 7-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. (US005940073A).

3. Klosterman et al. teaches (independent claims 1, 7 and 13) a method, computer readable storage medium and apparatus, the method comprising: maintaining an electronic program guide (EPG) for broadcast content (col. 5 lines 48-53); receiving content information (col. 4 lines 63-67) from a content service provider (*distribution center*, col. 4 lines 29-35) for one or more stored content data files (the content stored in the receiving devices, col. 4 lines 53-62); allowing the content service provider to determine a number of line items (e.g., information region ***220***) in an EPG to represent the content information for the one or more stored content data files (col. 5 lines 53-57) and allocating the determined number of line items in the EPG (Fig. 2(a)); allowing a user access to the one or more stored content data files (e.g., item ***260*** in Fig. 2(b)) via the electronic program guide (Fig. 2(a)) by linking, which reads on merging, the content information for display in the determined number of line items, wherein the EPG includes the content information for the one or more stored content data files and content information for the broadcast content (col. 5 lines 64-66 and col. 6 lines 5-15 and 47-54); and charging each of the one or more service providers a predetermined amount for each allocated line item (col. 6 lines 34-36 and 54-57).

4. Klosterman et al. does not explicitly teach that each stored content file occupies its own storage space. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that each stored content file necessarily occupies space, and that is

inherently "its own" space because the specification does not give any special meaning to "its own space". Storage space is disclosed only at para. [0035] of the published application (US 20020144269A1). The second sentence of that para. reads

"After the user watches a movie, *the storage space occupied by the movie* (emphasis added) is generally considered to be available for storage of another movie to be broadcast sometime later."

There is no disclosure that content is stored at any particular location. Hence, said *storage space occupied by the movie* is inherently the movie's "own space". Similarly, wherever each stored content file is stored inherently becomes "its own space".

5. Klosterman et al. does not teach that once the user accesses one of the one or more stored content data files, the storage space of the accessed stored content data file at the client device is made available for storage of another content data file not currently having its own storage space at the client device. Because storage space is not infinite, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Klosterman et al. that once the user accesses one of the one or more stored content data files, the storage space of the accessed stored content data file at the client device is made available for storage of another content data file not currently having its own storage space at the client device.

6. Klosterman et al. also teaches at the citations given above claims 2, 8, and 14; and claims 4, 10 and 16, where the content service provider is *NBC* and the allocated line item is item ***220*** in Fig. 2(a)).

7. Klosterman et al. also teaches claims 3, 9 and 15 (col. 11 lines 22-27, where *National News* in Fig. 9(a) is a category and Fig. 9(b) shows its allocated line items); and claims 5, 11 and 17 (col. 2 line 3 and col. 12 lines 12-20).

Investigation of Potential Allowable Subject Matter

8. The specification (para. [0035] of the published application, US 20020144269A1) discloses

"However, if there is no additional storage space available and a higher rated movie is to be broadcast, the lower rated unwatched movie is replaced by the higher rated movie in accordance with the teachings of the present invention".

This was not obvious to the examiner, so a search was performed for potential patentability. It was found that Chiba (US patent 4,115,855) essentially teaches this limitation (col. 1 lines 25-42), and, for reasons of storage efficiency, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Chiba to those Klosterman et al. Hence the subject limitation cannot make the application patentable.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

12. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

15. Applicant may have after final arguments considered and amendments entered by filing an RCE.

16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

14 October 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER